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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,213	01/20/2006	Andrzej Czernecki	POL0007-US	5246

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PAUL, HASTINGS, JANOFSKY & WALKER LLP
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Washington, DC 20005

EXAMINER

BELLAMY, TAMIKO D

ART UNIT	PAPER NUMBER
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2856

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,213	Applicant(s) CZERNECKI ET AL.	
	Examiner TAMIKO D. BELLAMY	Art Unit 2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 13, 15, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 9-12, 14, 16 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/20/05 & 6/7/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, **the external appliance communicates with the pipetting device by wire or in wireless manner** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 1 objected to because of the following informalities:

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- a. Claim 1, line 4, change “form” to –from--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 7 rejected under 35 U.S.C. 102(b) as being anticipated by Kenney (5,214,968).

Re claim 7, as depicted in fig. 1, Kenney discloses a pipette device (13) comprising a housing (e.g. outer cover 19) with a holder (e.g., coupling/ pipet supporting portion 21). Kenney discloses an air pump (e.g., air supply means 50) connected to the pipette (13) disposed in the housing (19) (Col. 2, lines 53-68; Col. 3, lines 1-11). Kenney discloses the housing (19) includes at least one valve (27) for controlling air atmospheric air flow (Col. 4, lines 27-35).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 8, 13, 15, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gomes (5,509,318) in view of Kenney (5,214, 968).

Re claim 1, as depicted in figs. 1, 3, and 5, Gomes discloses a housing (12) with a holder (e.g., collar 72) to mount the pipette (e.g., pipette housing 74). Gomes discloses an air pump (40) (Col. 3, lines 20-40). Gomes discloses a processor (e.g. microprocessor 100) for controlling the operation of the device and the amount of air is programmed in the processor (100) by determination of time of the supply of air to the pipette (Col. 3, lines 64-67; Col. 4, lines 36-47). Gomes lacks the detail of air supplied through a valve or a set of valves. as depicted in fig. 1, Kenney discloses an air supply means (e.g., 50) , and air supplied through a valve (e.g., valve mechanism 27). Therefore, to modify Gomes by employing air supplied through a valve would have been obvious to one of ordinary skill in the art at the time of the invention since Kenney teaches a portable pipet device having theses design characteristics. The skilled artisan would be motivated to combine the teachings of Gomes and Kenney since Gomes states that his invention is applicable to a hand held pipetting apparatus and Kenney is only used to provide the added limitation of the air supplied through a valve for the purpose of controlling the flow of the air.

Re claims 2 and 3, Gomes discloses the amount of air supplied to the pipette is determined basing on stored in the processor memory air flow function related to pipette (Col. 3, lines 64-67; Col. 4, lines 36-47).

Re claims 4-6 , as depicted in fig. 3, Gomes data concerning air flow are input to the processor memory from an external appliance, and the external appliance communicate with the pipetting device by wire (Col. 3, lines 64-67; Col. 8, lines 50-57).

Re claims 8 and 13, as depicted in figs. 1, 3, and 5, Gomes discloses a housing (12) with a holder (e.g., collar 72) to mount the pipette (e.g., pipette housing 74). Gomes discloses an air

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pump (40) (Col. 3, lines 20-40). Gomes discloses a processor (e.g. microprocessor 100) for controlling the operation of the device and the amount of air is programmed in the processor (100) by determination of time of the supply of air to the pipette (Col. 3, lines 64-67; Col. 4, lines 36-47). Gomes lacks the detail of air supplied through a valve or a set of valves. as depicted in fig. 1, Kenney discloses an air supply means (e.g., 50) , and air supplied through a valve (e.g., valve mechanism 27). Therefore, to modify Gomes by employing air supplied through a valve would have been obvious to one of ordinary skill in the art at the time of the invention since Kenney teaches a portable pipet device having theses design characteristics. The skilled artisan would be motivated to combine the teachings of Gomes and Kenney since Gomes states that his invention is applicable to a hand held pipetting apparatus and Kenney is only used to provide the added limitation of the air supplied through a valve for the purpose of controlling the flow of the air.

Re claim 15 , as depicted in fig. 3, Gomes data concerning air flow are input to the processor memory from an external appliance, and the external appliance communicate with the pipetting device by wire (Col. 3, lines 64-67; Col. 8, lines 50-57).

Re claim 18, Gomes discloses the function of the programmed dispensing button is after programmed switching by processor (100) taken over by the liquid aspiration button (Col. 6, lines 66-67; Col. 7, lines 1-25).

Re claim 19, Gomes discloses the amount of air supplied to the pipette is determined basing on stored in the processor memory air flow function related to pipette (Col. 3, lines 64-67; Col. 4, lines 36-47).

Allowable Subject Matter

7. Claims 9-12, 14, 16, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMIKO D. BELLAMY whose telephone number is (571)272-2190. The examiner can normally be reached on Monday - Friday 7:30 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tamiko Bellamy

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/T.B./

February 29, 2008

/Hezron Williams/

Supervisory Patent Examiner, Art Unit 2856